

REMARKS/ARGUMENTS

In response to the Office Action mailed June 3, 2004, Applicants amend their application and request reconsideration in view of the amendments. In this Amendment, Claim 1 was amended, Claims 34-36 have been cancelled, without prejudice, and no claims have been added so that Claims 1-33 are currently pending. No new matter has been introduced.

Claims 1-5, 11-16, 27 and 34-36 were rejected as being anticipated by U.S. Patent No. 6,001,118 to Daniel et al. (Daniel). This rejection is respectfully traversed.

Anticipation exists only if all of the elements of the claimed invention are present in a system or method disclosed, expressly or inherently, in a single prior art reference. Therefore, if it can be shown that there is one difference between the claimed invention and what is disclosed in the single reference, there can be no anticipation.

Daniel discloses an emboli capturing system. The system comprises a guidewire or a hypotube having the same general dimensions as a guidewire and a capturing assembly. The guidewire includes a coil tip and the capturing assembly includes an inflatable and expandable member and mesh. An inflation means is in fluid communication with the lumen of the guidewire and to the expandable member. Other embodiments include devices with inflatable struts. In each of the devices the filter is somehow connected to the guidewire, for example, for inflation.

Daniel fails to disclose or remotely suggest a stand alone filter that is not connected to a guidewire. Daniel specifically discloses guidewires and inflation means. Since Daniel fails to disclose all of the claimed elements, there can be no anticipation. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1-3 and 7-10 were rejected as being anticipated by U.S. Patent No. 6,179,859 to Bates et al. (Bates). This rejection is traversed.

Bates disclosed an embolic filtration system. The system comprises a guidewire having a filter element mounted thereon. The apparatus allows for rotation of the filter element over the guidewire. A delivery sheath covers the filter element. The filter element comprises a plurality of rings attached to a capture ring.

As with Daniel, Bates fails to disclose a stand alone, guidewireless filter as in amended Claim 1. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claim 6 was rejected as being unpatentable over Daniel. This rejection is respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d,488,20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.”

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re*


Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

Applicants respectfully reiterate the arguments presented above with respect to the anticipation rejection. Daniel fails to disclose or even remotely suggest the features of Claim 1. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

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